

REMARKS

By the present amendment, claim 34 has been amended to clarify that the value of the security paper is independent from the security facility. Support for this amendment is immediately derived from the disclosure in the original application, in particular on page 3, lines 24-28. Further, claims 33 and 35 have been amended to delete the phrase introduced by “such as” and the term “in particular”, and claim 34 has been amended to delete the phrase “in particular banknote paper”. Accordingly, a new claim 36 dependent on claim 34 and reciting a banknote paper has been added. Also, new claims 37-50 have been added. New claims 37-47 correspond to claims 21-31 but are dependent on claim 34. Support for new claim 48 is found in the original application, in particular on page 5, lines 33-34 of the specification, and support for new claims 49-50 is found in the original application, in particular on page 7, lines 3-25.

As a preliminary, Applicants and Applicants’ representative thank the Examiner for the personal interview which was held on June 7, 2004. Claim 34 has been amended as discussed during the interview.

Claims 19-50 are pending in the present application. Independent claim 19, and claims 20-32 dependent directly or indirectly thereon, are directed to an authenticity evaluation method of substrates having a security facility, independent claims 33 and 35 are directed to a permanent security facility for use as security in substrates, and independent claim 34, and claims 36-50 dependent directly or indirectly thereon, are directed to a security paper.

In the Office Action, claims 33 and 35 are objected to for reciting the phrases “such as...” and “in particular”.

The phrase introduced by “such as” and the term “in particular” have been deleted in

claims 33 and 35. Accordingly, it is submitted that the objection should be withdrawn.

Next, in the Office Action, claim 34 is rejected under 35 U.S.C. 102(b) as anticipated by US 4,970,260 to Niepolomski et al. (Niepolomski).

Reconsideration and withdrawal of the rejection is respectfully requested. As discussed during the interview, Niepolomski discloses a debit card which has a value directly related to the diode assembly. Specifically, Niepolomski explains in introduction that fraud is facilitated when the “reading” function (i.e., authenticity evaluation) and “cancellation” function (i.e., value setting) of the card are separated (see Niepolomski at col. 1, lines 41-49). Accordingly, Niepolomski provides an authenticity evaluation system with “value markings”, which perform the double function of authenticity marking and value marking (see Niepolomski at col. 2, lines 1-12). In other words, in the debit card of Niepolomski, the diodes define the value of the card, and the “value markings” operate such that the value of the card is modified according to how many diodes are destroyed when the card is used.

In contrast, in the presently claimed invention, the security document has a value which is independent from the security facility, as recited in present claim 34. In other words, the security paper has a value that is not determined by the security facility. An advantage of the security paper according to the presently claimed invention is that the security facility can be used as an authenticity marking for various security papers, as the value of the security paper is independent from the authenticity marking, as is the case for banknotes, for example. This feature of the presently claimed invention and its advantages are not taught or suggested in Niepolomski, and therefore, present claims 34 and 36-48 are not obvious over Niepolomski.

In view of the above, it is submitted that the rejection should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 50-2866.

Respectfully submitted,

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